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PITNEY BOWES INC.
INTELLECTUAL PROPERTY & TECH. LAW DEPT.
35 WATERVIEW DRIVE
MSC 26-22
SHELTON, CT 06484

EXAMINER

MYHRE, JAMES W

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN K. ECKL

Appeal 2006-001650
Application 09/903,500
Technology Center 3600

Before: WILLIAM F. PATE III, JENNIFER D. BAHR and
ANTON W. FETTING, *Administrative Patent Judges*.

PATE III, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF CASE

This is a decision on rehearing in Appeal No. 2006-001650. We have jurisdiction under 35 U.S.C. § 6(b).

Requests for Rehearing are limited to matters misapprehended or overlooked by the Board in rendering the original decision. 37 C.F.R. § 41.52.

ISSUES ON REHEARING

Appellant raises two issues in the Request for Rehearing. The first issue relates to the construction of the claim term “delivery preferences” and whether the disclosure in Comesanas of a signed written agreement by the customer to pay a mandatory electronic billing fee can be regarded as a customer or recipient delivery preference. Request for Reh’g 2-5.

Appellant included a second set of arguments in the Request entitled “*Res Judicata* Rejections.” Request for Reh’g 6. Appellant goes on to argue that this is not a situation where *res judicata* applies. We agree. This is not a situation in which *res judicata* applies. The applicable principle at issue is one of waiver—specifically, the disposition of claims which Appellant has declined to separately argue. 37 C.F.R. § 41.37(c)(1)(vii) (2007). Therefore, the second issue upon rehearing is whether the Panel erred by deciding a second appeal with a finding that the Appellant waived any further argument to claims which the Panel had previously found properly rejected in the first appeal.

Issue I. Prior Art Rejections

In our 2007 decision we held that even if the claims were construed so that “delivery preferences” referred solely to the choice of a printed or an

electronic invoice, Comesanas rendered the claimed subject matter prima facie obvious. Decision of Mar. 29, 2007, 7-8. Appellant, in the Request for Rehearing, after quoting the sentence from Comesanas on which we based our decision, states that we have drawn an incorrect conclusion from the sentence that is a starting point for a flawed line of reasoning. Appellant states that our conclusion that “unless the debtor/customer chooses to pay the fee, the debtor customer cannot receive electronic billing” is neither stated nor implied. Request for Reh’g 5, citing Comesanas, col. 3, ll. 17-26. We disagree. In an e-commerce regime in which there is a charge for payment of a bill online and the creditor is “unwilling” to pay the charge, then the debtor must pay the fee to be allowed to receive electronic billing. There are only two parties to the transaction--the creditor who is owed the invoice amount and the debtor/customer. One of these parties must pay. In the e-commerce universe that Comesanas posits, in which there is a fee for paying the invoiced amount online, and the creditor is unwilling to pay the fee, then to receive electronic billing with online payment the debtor/customer must pay the fee. It is as simple as that. This is why Comesanas requires a written agreement on the part of the customer to pay the fee. There must be an acknowledgement on the customer’s part that he prefers electronic billing even with the attendant fee.

Appellant argues that confusion has resulted from the fact that e-commerce has evolved without charges for individual electronic transmittals. We agree that an e-commerce regime that charges for individual electronic transmittals has not been widely adopted, but this is simply irrelevant to the express written disclosure of Comesanas which envisions such a fee.

Appellant makes much of the phrase “all-electronic business environment” as it appears in the contested sentence of Comesanas. We agree that a proper interpretation of this expression is important to an understanding of Comesanas’ invention. Comesanas is stating that his invention has an all-electronic mode that the debtor/customer can opt in to by signing a print written agreement that he authorizes being billed for electronic transmittal charges. Comesanas, col. 3, ll. 17-24. We agree with Appellant’s characterization of this as an electronic counterpart to the printed implementation. However, we read this sentence to require the debtor/customer to participate in the prepayment feature to also participate in the electronic system. In other words, we do not agree with Appellant’s contention that in declining to participate in the prepayment feature the debtor/customer would still be allowed to participate in the electronic system. In short, this sentence in Comesanas links participation in the electronic system with a willingness to pay the charges for electronic return payment. No amount of sophistry on the part of Appellant can alter this simple fact.

We must further emphasize that Appellant’s argument that an “all-electronic business environment” might include a user “left to his own means to put on his own stamp” or otherwise return the payment physically to the billing party hardly describes an all-electronic system. Thus, since an “all-electronic” payment system must include electronic payment and there is a charge for such a payment, and the debtor customer must accede to this charge before electronic payment can be utilized, Comesanas certainly contemplates a business method in which a recipient’s delivery preference,

i.e., the preference to pay for the electronic transmittal fee, is stored and matched to the recipient in the biller's processing of the billing statement.

Issue II. Waiver

To the extent that our 2007 Decision dismissed the Appeal as to claims 21-36, we are of the view that the Decision overreached. Accordingly, the Request for Rehearing is granted to the extent that we vacate our decision to dismiss the Appeal with respect to claims 21-36. We reinstate claims 21-36 in the Appeal.

We note Appellant's statement in the Request that claims 21-36 stand or fall with claim 18. Request for Reh'g 6, ll. 27-29. Since we have affirmed the rejection of claim 18 at Issue I. of this decision, we hold that claims 21-36 fall with claim 18.

CONCLUSION

Nothing in Appellant's request has convinced us that we have overlooked or misapprehended the disclosure of Comesanas as argued by Appellant. Accordingly, we granted the Request for Rehearing to the extent that we reconsidered our holding that all claims on appeal are unpatentable, but we deny the request insofar as it asks for changes to that holding.

We granted Appellant's request to the extent that we reinstated the Appeal with respect to claims 21-36. We upheld the rejections of these claims for the reasons given with respect to claim 18, with which they fall.

REHEARING GRANTED-IN-PART and DENIED-IN-PART
AFFIRMED

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nhl

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